

## **REMARKS**

Claims 3, 4, 6, 7 and 8 are pending in the current application according to the Office Action dated January 20, 2004.

Claims 9-11 are new and relate to the method of using the claimed composition on plants.

Maintenance of the restriction requirement is acknowledged. Applicants maintain traverse that the restriction is improper, but in the interest of furthering prosecution, have amended the claims in conformance with the finalized requirement.

### **Rejections under 35 U.S.C. § 112**

Applicants traverse the rejection to Claim 6. Claim 6, currently amended, reads on insects that are pests in agriculture. Aphis and Myzus spp. are insects that are pests in agriculture. Applicants aver that the examples provided in the specification fully enable the claim.

### **Rejections under 35 U.S.C. § 103**

Claims 3 and 4 stand rejected for obviousness in light of Hunter (WO 98/42191) Erdelen (DE 195 19007) and Fischer (US 5,262,383). An English-language equivalent to Hunter is US 6,716,442; an English-language equivalent to Erdelen is US 6,444,690. The US patents will be utilized in the following discussion.

Hunter describes a method for eradication of fleas in domestic or accomodation premises of a domestic or laboratory mammal by the topical application of a phenylpyrazole insecticide namely fipronil (column 9, line 8), optionally in combination with imidacloprid[e] (column 3, line 64). The present invention claims neither a combination nor a method of using the combination on animals. Hunter is moot.

Erdelen describes a synergistic insecticidally effective combination of imidacloprid and *inter alia*, abamectin. A combination of the compound of formula (Ia) and imidacloprid, claimed in the present invention, is not described. Erdelen is moot.

The Office Action indicates that Fischer teaches the “homology” of the compound of formula (Ia) at Table 2. As the Office Action implicitly acknowledges therefore, the specific compound of formula (Ia) is not disclosed in Fischer. If what is meant in the Office Action that the “homology” of formula (Ia) is taught, then to the extent that the statement conforms with Applicants’ interpretation that the specific compound of formula (Ia) is not taught, the statement is acknowledged. Applicants acknowledge that in Fischer at column 131, lines 28-36, it is taught that active compounds may be mixed with insecticides; and furthermore that the insecticides include “phosphates, carbamates, carboxylates, chlorinated hydrocarbons, phenylureas, and substances produced by microorganisms.” Specifically agonists of nicotinic acetylcholine receptors and one or more antagonists of nicotinic acetylcholine receptors, described in the present application, are not mentioned to be combined with the active compounds of Fischer. Imidacloprid specifically is not mentioned as mixture partner with the compounds of Fischer..

While it is acknowledged that the compound of formula (Ia) is embraced by the generic formula of Fischer, there is no specific teaching that the person of ordinary skill in the art should apply the compound of formula (Ia) in the instant application with imidacloprid.

The Office Action therefore improperly states that the person of ordinary skill in the art would find it obvious to prepare the particular claimed combination. Applicants traverse this rejection. There is no *prima facie* case supported by Fischer, Hunter, and Erdelen taken individually or in combination.

In order to arrive at the instantly claimed combination the person of ordinary skill in the art would have to be prepare the compound of formula (Ia) by modifying Erdelen and combining the compound of formula (Ia), that with imidacloprid and/or thiacloprid. This is too much to reasonably expect of the person of ordinary skill in the art. There is no reasonable expectation of success, even if he could arrive at the claimed combination.

The Court of Appeals of the Federal Circuit has repeatedly stated that the standard for obviousness in such a situation is that even if the art must be modified, the art must still provide a suggestion for the modification. See In re Gordon, 733 F.2d 900, 902 (Fed. Cir. 1984): “The mere fact that the prior art could be modified

would not have made the modification obvious unless the prior art suggested the desirability of the modification.”

There is no suggested desirability of the modification of the prior art to achieve a synergistic combination of the compound of formula (Ia) and imidacloprid and/or thiacloprid. First, the skilled person would have to prepare the compound of formula (Ia) from the disclosure of Fischer. This would take a large amount of preparation. Then he would have to select the compound of formula (Ia) from the myriad of compounds of Fischer. Then by some imagination, and no suggestion from teaching cited herein, the skilled person would have to select a combination of imidacloprid and the compound of formula (Ia). There is no such teaching. Neither Hunter nor Erdelen speak to or suggest the claimed invention.

Notwithstanding the complete lack of a *prima facie* case of obviousness as set forth in the Office Action, Applicants rely upon the data in the specification (see pp 31-42) as a sufficient showing of unexpected results.

Reconsideration of the claims in light of the above arguments and modifications is requested.

Applicants cannot find in their files copending application 10/239,332 or 10/123,332. Applicants would be pleased to resolve this matter with the Examiner via telephone or receive a new Office Action clarifying the rejection under the judicially created doctrine of obviousness-type double patenting. Reconsideration of the instant claims in light of the unknown applications 10/239,332 or 10/123,332 is requested.

Respectfully submitted,

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